

REMARKS

Reconsideration of this Application is respectfully requested. Claims 15-21, 23-27, 34-36, 38-43 and 47-52 are pending in the application, with claims 15, 23 and 34 being the independent claims. Claims 28-29, 32-33 and 44-46 have been cancelled without prejudice of the subject matter therein to narrow the outstanding issues. The Applicants reserve the right to pursue these claims at a later time.

Rejections Under 35 U.S.C. § 112

Claims 23 and 28 stand rejected under the first paragraph of 35 U.S.C. § 112 as failing to comply with the written description requirement.

In the Advisory Action, the Examiner disagrees with the Applicants' remarks previously submitted in response to the Office Action. Specifically, the Examiner states that broadly disclosing in the specification disabling functionality within the personal identification device (see paragraph [0081]) and claiming specific features, such as, for example, disabling functionality within the personal identification device "except that the personal identification device is configured to send the digital certificate to an enrollment party during future enrollment" as recited in independent claim 23 is not the same or equivalent and is without support in the specification. The Examiner similarly asserts that independent claim 28 is without support in the specification.

The Applicants respectfully disagree. In the Advisory Action, the Examiner's reference to the specification for support for disabling functionality within the personal identification device only refers to the first portion of the last sentence of paragraph [0081] of the specification but ignores the second portion of the sentence. The sentence recites, in its entirety, that "*at this point* all functionality within the personal identification device is disabled, *such that it is in a state waiting for future enrollment (step 107).*" Emphasis added. Thus, when paragraph [0081] refers to "at this point," it is referring to the point after pre-enrollment (e.g., the preceding portion of paragraph [0081]) and before the enrollment process (e.g., paragraphs [0082] and [0083]). The subsequent set of paragraphs of the specification, paragraphs [0082] and [0083], describe a process for

enrolling personal identity credentials into the personal identification device. In other words, paragraphs [0082] and [0083] describe functionality of the personal identification device that is left enabled after the end of the pre-enrollment process referred to in paragraph [0081] (e.g., when the personal identification device is in a wait state for future enrollment).

Independent claim 23 recites “sending the digital certificate to the personal identification device such that functionality of the personal identification device is disabled except that the personal identification device is configured to send the digital certificate to an enrollment party during future enrollment.” The personal identification device is in a wait state associated with future enrollment and has functionality associated with future enrollment enabled such as sending the digital certificate from the personal identification device to the enrollment party.

As Previously Discussed, The Claims are Patentable Over Russo in view of Prokoski

Claims 15-21, 23-29, 32-36 and 38-52 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2003/0115475 to Russo et al. (“*Russo*”) in view of U.S. Patent No. 6,850,147 to Prokoski et al. (“*Prokoski*”). Applicants note that the Advisory Action does not appear to address this rejection. This rejection is traversed for the reasons set forth in the prior response and repeated below for completeness.

The rejection of claims 28-29, 32-33 and 44-46 is moot in light of the cancellation of these claims. Accordingly, the Applicants request that the rejection of independent claim 28 and its dependent claims under the first paragraph of 35 U.S.C. § 103(a) be withdrawn.

All of *Prokoski*’s disclosure identified by the Examiner (col. 5, lines 30-55; col. 6 lines 7-27; and col. 7, lines 3-23) is directed to post-enrollment events and not pre-enrollment events. For example, *Prokoski* discloses a personal biometric key that can be used to unlock or access any device that has a biocompatible receiver during post-enrollment use. (See col. 6, lines 19-25).

Unlike independent claim 15, which recites “disabling functionality within the personal identification device except that the personal identification device is in a wait

state associated with future enrollment,” *Russo* in view of *Prokoski* is entirely silent. As the Examiner states, *Russo* does not explicitly teach the above recited claim language. *Prokoski*, as described above, merely discloses post-enrollment use. Moreover, *Prokoski* fails to disclose or suggest any disabling of functionality within the personal identification device or a wait state associated with future enrollment. Accordingly, the Applicants request that the rejection of independent claim 15 and its dependent claims 16-21, 38-40 and 50 under 35 U.S.C. § 103(a) be withdrawn.

Unlike independent claim 23, which recites “producing a digital certificate ... before enrollment of biometric data and sending the digital certificate to the personal identification device such that functionality of the personal identification device is disabled except that the personal identification device is configured to send the digital certificate to an enrollment party during future enrollment,” *Russo* in view of *Prokoski* is entirely silent. As the Examiner states, *Russo* does not explicitly teach the above recited claim language. *Prokoski*, as described above, is directed to post-enrollment use. Moreover, *Prokoski* does not disclose or suggest a personal identification device that has its functionality disabled except that functionality to send the digital certificate to an enrollment party during future enrollment is not disabled. Accordingly, the Applicants request that the rejection of independent claim 23 and its dependent claims 24-27, 41-43 and 51 under 35 U.S.C. § 103(a) be withdrawn.

Unlike independent claim 34, which recites “disabling functionality within the personal identification device except for functionality associated with future enrollment,” *Russo* in view of *Anthony* is entirely silent for at least the reasons discussed above with respect to independent claim 15. Accordingly, the Applicants request that the rejection of independent claim 34 and its dependent claims 35-36, 47-49 and 52 under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

All of the stated grounds of rejection have been properly overcome. The Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. The Applicants believe that a full and complete

response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that further personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this application is respectfully requested.

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